

### **REMARKS/ARGUMENTS**

This Amendment is in response to the Office Action mailed December 19, 2008. Claims 1-35 were pending in the present application. Claims 1-23 are rejected under 35 U.S.C. §101 as allegedly being drawn to non-statutory subject matter. Claims 6, 11, 18, 19, and 21-23 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1-35 are rejected as allegedly being anticipated by *Calabria* (US 2005/0137939). Applicants respectfully disagree. In view of the following remarks, reconsideration of the rejected claims is respectfully requested.

#### **I. Examiner Interview**

A telephone interview was conducted with Examiner Retta on February 26, 2009. The undersigned attorney represented the Applicants in the interview. In the interview, an overview was given of the subject matter of Applicants' claims, and differences between this subject matter and the cited references were discussed. While no agreement was reached with respect to the claims, the Examiner provided helpful suggestions for clarifying the language and highlighting at least some of the differences with respect to the cited art. Applicants appreciate the Examiner's helpful suggestions, and have amended the claims accordingly. Applicants thus respectfully submit that the claims as amended are allowable over the cited references.

#### **II. Claims 1-23 Recite Statutory Subject Matter**

Claims 1-23 are rejected under 35 U.S.C. §101 as allegedly being drawn to non-statutory subject matter. Claims 1 and 13 as amended recite "computer-implemented" methods, wherein the elements of the methods are performed "under control of one or more computer systems configured with executable instructions". It thus is respectfully submitted that claims 1 and 13, and the claims that depend therefrom, are tied to a statutory class of invention, and thus recite statutory subject matter. Applicants therefore respectfully request that the §101 rejections with respect to claims 1-23 be withdrawn.

### **III. Claims 6, 11, 18, 19, and 21-23 Are Not Indefinite**

Claims 6, 11, 13, 14, 18, 19, and 21-23 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. It is respectfully submitted that claims 6, 19, and 21-23 have been canceled from the present application, and claim 11 no longer recites the language that was rejected in the Office Action, such that the rejections with respect to these claims are now moot. Further, claim 13 as amended specifies that the advertisement is "an advertisement for the item", and further recites language clarifying questions raised in the Office Action, such that dependent claim 18 should be sufficiently definite. Further, claims 13 and 14 as amended recite proper antecedent basis for each term recited therein. Applicants therefore respectfully request that the §112 rejections with respect to these claims be withdrawn.

### **IV. Claims 1-35 Are Not Anticipated by *Calabria***

Claims 1-35 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Calabria* (US 2005/0137939). Applicants respectfully disagree.

Under 35 U.S.C. §102 "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that *Calabria* does not disclose each and every element of Claims 1-35.

#### **A. Independent Claim 1**

Applicants' claim 1 as amended recites a "computer-implemented method for determining when to place an advertisement for an item on a first page of search results for a search request related to the item," comprising:

under control of one or more computer systems configured with executable instructions, receiving search result data relating to previously-executed searches that each included a link to information for the item in a corresponding set of search results, the search result data for each previously-executed search indicating at least a search term submitted by a user, placement of the link within the corresponding set of search results provided for display to the user, and whether the user selected the link for the item from the search results;

determining, based at least in part on the received search result data, an extent to which users who entered the search term subsequently selected the link to the item from the search results, the extent being a function of a frequency of selection of the item when the link is displayed and a page number on which the link was presented in the search results, the extent being determined to be greater for a higher page number at the same frequency of selection; and

upon receiving a subsequent search request containing the search term, determining to place an advertisement for the item on the first page of the search results for the search request when the extent to which users selected the link to the item exceeds calculated extents for other items in the search results for the subsequent search request, independent of a page number of the search results on which the link for the item is configured to be displayed.

Such limitations are not disclosed by *Calabria*.

*Calabria* discloses approaches for “automatically generating a plurality of bids for an advertiser for placement of at least one advertisement in association with a search results list” (paragraph [0021]). Candidate advertisements are received from an advertiser, and a list of candidate keywords is associated with each candidate advertisement (paragraph [0021]). For each “advertisement-keyword pair”, a click-through-rate (CTR) is calculated, as well as a “return on advertising investment (ROAI)” and, ultimately, a “bid amount” (paragraphs [0021]-[0022]). This information can be used to select “appropriate keyword advertisements” for inclusion in a “keyword search results list” to be “communicated to the user” (paragraph [0039]). This is very different from what is recited in Applicants’ claim 1 as amended.

*Calabria* does not, however, disclose or suggest “receiving search result data relating to previously-executed searches that each included a link to information for the item in a corresponding set of search results” where the search result data for each previously-executed search indicates “at least a search term submitted by a user, placement of the link within the corresponding set of search results provided for display to the user, and whether the user selected the link for the item from the search results” as recited in Applicants’ claim 1 as amended.

*Calabria* also does not disclose or suggest determining “an extent to which users who entered the search term subsequently selected the link to the item from the search results,” where the extent is “a function of a frequency of selection of the item when the link is displayed and a page number on which the link was presented in the search results” as recited in claim 1. *Calabria* does not disclose or suggest such an extent “being determined to be greater for a higher page

number at the same frequency of selection” as recited in Applicants’ claim 1. *Calabria* also does not disclose or suggest, upon receiving a subsequent search request containing the search term, “determining to place an advertisement for the item on the first page of the search results for the search request when the extent to which users selected the link to the item exceeds calculated extents for other items in the search results for the subsequent search request,” which is “independent of a page number of the search results on which the link for the item is configured to be displayed”. For at least these reasons, *Calabria* cannot anticipate Applicants’ claim 1, or the claims that depend therefrom.

**B. Dependent claims 2, 4-5, and 9-12**

Claims 2, 4-5, and 9-12, which each depend from claim 1 as discussed above, are allowable for at least the same reasons as the respective independent claim.

Further, at least some of these claims recite subject matter that also is clearly distinguishable over *Calabria*. For example, Applicants’ claim 2 recites that “the link for the item is not placed on the first page of the search results for the subsequent search request.” Claim 4 recites that the “search result data” as recited in claim 1 “is generated by a search engine service”, while claim 5 recites that the “search result data” is “received from a search engine service.” Claim 9 recites that the “search result data is derived from information sources”, claim 10 recites that “the information sources include web pages”, and claim 11 recites that “the information sources include content not available through the Internet.” Such elements are also not disclosed or suggested by *Calabria*, such that at least some of these claims are further patentable in their own right.

**C. Independent Claims 13 and 24**

These claims each recite subject matter that is also not disclosed or suggested by *Calabria* for reasons including at least some of those set forth above with respect to claim 1, such that these claims also are not anticipated by *Calabria*. For example, Applicants’ claim 13 recites “determining an extent to which users selected a link to an item presented in search results for previously-submitted queries including the search term and related to the item when the link was included on a page other than a first page of the search results,” where the extent is

“determined to be greater for a higher page number at a common frequency of selection.” Claim 13 also recites “requesting an advertisement for the item to be placed on the first page of search results to be presented in response to the received search query,” which is “independent of a page number of the search results on which the link for the item is configured to be displayed.” Such elements are not disclosed or suggested by *Calabria*.

Further, Applicants’ claim 24 recites means for “determining an extent to which users selected a link to an item presented in search results for previously-submitted queries including the search term and related to the item when the link was included on a page other than the first page of the search results,” where the extent is “determined to be greater for a higher page number at a common frequency of selection.” Claim 24 also recites means for “requesting an advertisement for the item to be placed on the first page of search results to be presented in response to the received search query,” which is “independent of a page number of the search results on which the link for the item is configured to be displayed.” Such elements also are not disclosed or suggested by *Calabria*.

As *Calabria* does not disclose or suggest such elements, *Calabria* cannot anticipate Applicants’ claims 13 or 24, or the claims that depend therefrom.

**D. Dependent claims 14-18, 20, and 25-31**

Claims 14-18, 20, and 25-31, which each depend from one of claims 13 or 24 discussed above, are allowable for at least the same reasons as the respective independent claim.

Further, at least some of these claims recite limitations that also are clearly distinguishable over *Calabria*. For example, Applicants’ claim 14 recites that “a search engine service provides the link to be included with the search results without payment of an advertising fee, and claim 18 recites that “a fee paid for the advertisement associated with the search term is based on prominence of the placement of the link in the search result and number of selections of the link to the item of search results.” Claim 29 recites that “a fee paid for the advertisement associated with the search term is based on prominence of the placement of the link in the search result and number of selections of the link to the item of search results,” and claim 30 recites that

“a larger fee is paid when the placement is less prominent.” Such elements are also not disclosed or suggested by *Calabria*, such that at least some of these claims are further patentable in their own right.

Applicants therefore respectfully request that the anticipation rejections with respect to these claims be withdrawn.

#### **V. Amendment to the Claims**


Unless otherwise specified or addressed in the remarks section, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter. In addition, by focusing on specific claims and claim elements in the discussion above, applicants do not imply that other claim elements are disclosed or suggested by the references. In addition, any characterizations of claims and/or cited art are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by another prosecution. Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that applicants have made any disclaimers or disavowals of any subject matter supported by the present disclosure.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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